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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
PSTM003/MRK

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on April 26, 2006

Signature Alexandra AllisonTyped or printed
name Alexandra AllisonApplication Number
09/684871Filed
10/6/2000

First Named Inventor

David Allison Bennett, et al.

Art Unit
3629Examiner
Webb, Jamisue A.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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April 26, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.

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Alexandra Allison

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : David Allison Bennett, et al.
Application No. : 09/684,871
Filed : October 6, 2000
Title : APPARATUS, SYSTEMS AND METHODS FOR ONLINE,
MULTI-CARRIER, MULTI-SERVICE PARCEL SHIPPING
MANAGEMENT FEATURING SHIPPING LOCATION
COMPARISON ACROSS MULTIPLE CARRIERS
Grp./Div. : 3629
Examiner : Webb, Jamisue A
Docket No. : PSTM0003/MRK

PRE-APPEAL BRIEF REQUEST FOR REVIEW REASONS

Mail Stop AF 140 S. Lake Ave., Suite 312
Commissioner for Patents Pasadena, CA 91101-4710
P.O. Box 1450 April 26, 2006
Alexandria, VA 22313-1450

Commissioner:

In an Office Action dated January 27, 2006, a Final rejection, Claims 1-21 were rejected under 35 USC 103(a) as being unpatentable over Nicholls et al. (U.S. Patent No. 5,485,369; "Nicholls") in view of Kara (U.S. Patent No. 6,233,568; "Kara") in further view of Barnett (U.S. Patent No. 6,369,840; "Barnett"). Claims 1-21 are sometimes referred to herein collectively, as the "rejected Claims".

After carefully considering the rejections, this Request is filed pursuant to the guidelines for requesting a pre-appeal brief conference as presented in the Official Gazette (the "OG"), dated July 12, 2005. A pre-appeal brief panel review of the rejection of the rejected Claims is respectfully requested on grounds described in more detail below with reference to the Claims of the present application as amended in the Amendment and Response filed in response to the Office Action dated August 1, 2005. This Request is timely filed within the three-month period set by the Examiner because it is filed before the expiration of April 27, 2006. Reconsideration and allowance of the application in view of this Request is respectfully requested.

A. No MPEP §706.02(j) PRIMA FACIE MOTIVATION TO COMBINE BARNETT

It is respectfully asserted that there is no teaching or suggestion, and that the rejections did not identify any teaching or suggestion, found in the prior art, as required under MPEP §706.02(j), to combine Barnett with the other cited reference. See also

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MPEP §2143. More specifically, it is respectfully asserted that there is no teaching or suggestion, and that the rejections did not identify any teaching or suggestion, found in the prior art, as required under MPEP §706.02(j), to combine *Barnett* (regarding "events belonging to different categories"; see *Barnett*, col. 2, lines 26 – 29) with the other cited references with respect to the subject matter of e.g., Claim 1 of the present application that is directed to "... generat[ing] a simultaneous online display ..." regarding a *single event*, i.e., "...shipping of the particular parcel from the respective default shipping location ...". See also MPEP §2143.

In the Final Office Action, the Claims were rejected in view of *Barnett* on the grounds that "[i]t would have been obvious ... to display the calculation of shipping rates, calculated by Nicholls and Kara and generate a display of a plurality of services, as disclosed by Barnett, in order to provide a multi-layers system wherein different categories can be overlaid on one another providing a single integrated display that allows a user to order or purchase a system based on the calendar day and time ..." (citing Barnett, col. 2). Final Office Action, Topic No. 4.

It is respectfully submitted that "... provid[ing] a multi-layered calendaring system wherein events *belonging to different categories* and selected by a user can be overlaid on one another in a single integrated calendar ..." (as disclosed in *Barnett*, col. 2, lines 26 – 29 (emphasis added)), does not provide any teaching or suggestion as required by MPEP §§706.02(j) to combine *Barnett* with the other cited reference with respect to the above-cited limitations of e.g., Claim 1 of the present application. Therefore, it is respectfully asserted that *Barnett* is not properly combined with the other cited references and that, therefore, the Claims of the present application should be allowed.

B. No SHOWING UNDER MPEP §2143 FOR EACH LIMITATION OF EACH CLAIM

Even assuming for the sake of argument that *Barnett* was properly combined with the other cited references, it is respectfully asserted that the rejections did not indicate, as required under MPEP §2143, how the cited references, even when combined, disclose, anticipate, teach or suggest *each* of the limitations of each of the rejected Claims.

For example, Claim 1 of the present application recites limitations for which the rejection failed to indicate, as required under MPEP §2143, any disclosure, anticipation,

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teaching or suggesting by the cited references, even when combined. Claim 1 recites (and Claims 8 and 15 similarly recite), among other things, a limitation to:

... generate a simultaneous online display of a plurality of delivery services for each carrier of the plurality of carriers that would support shipping of the particular parcel from the respective default shipping location...

It is respectfully submitted, for the reasons explained in more detail below, that the rejection failed to show that combining *Barnett* with the other cited references discloses, anticipates, teaches or suggests the above-cited limitations of Claim 1.

As compared to the above-quoted limitation of Claim 1 (and as compared to similar limitations recited by Claims 8 and 15), neither *Nicholls* nor *Kara* disclose, anticipate, teach or suggest "... generat[ing] a simultaneous online display of a plurality of delivery services for each carrier of the plurality of carriers that would support shipping of the particular parcel from the respective default shipping location...". Rather, as shown in, e.g., FIG. 4A of *Nicholls*, *Nicholls* discloses that either "...the service is selected [by the user] from the Service box ..." or that "...the service may be set to Best Way and the system will choose the least cost carrier which meets the transit time requirements indicated in the commitment field ...". See *Nicholls*, Col 7, lines 53-60.

Similar to *Nicholls*, *Kara* discloses a user pre-selection of a particular delivery service and a subsequent display of carrier-specific rates for the pre-selected delivery service adjacent to an identifier of the respective carrier. See, e.g., *Kara*, Figure 8A; *Kara*, col. 5, lines 56 – col. 6, line 6; *Kara*, col. 22, lines 21-48 (disclosing a "... program [that] automatically calculates the [shipping] fees for each shipping service provider offering service *commensurate with the desired shipping and/or delivery parameters* ...") *Kara*, col. 22, lines 39 – 42 (emphasis added)). Therefore, according to *Kara*, a user of *Kara* must first indicate the desired shipping and/or delivery parameters (e.g., Overnight, or Same Day, or Next Day, or 2-Day, or 3-Day) so that the *Kara* "program [will] automatically calculate[] the [shipping] fees for each shipping service provider offering service *commensurate with the desired shipping and/or delivery parameters*." *Kara*, col. 22, lines 39 – 42 (emphasis added). That is, only once a user has indicated a

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desired type of service, will the Kara program calculate the shipping rate for each carrier that supports *the desired service* and then display the results.

Importantly, as compared to the above-cited limitation of Claim 1, as can be seen in FIG. 8 of Kara, Kara would display only one rate per carrier at a time. In order to obtain a comparison of rates using Kara, it is respectfully submitted that a user would need to successively indicate an "urgency", e.g., "Overnight" on FIG. 8 of Kara, so that the Kara system would, according to the specification of Kara (e.g., Kara, col. 22, lines 39 – 42), calculate the rates for the shipping service providers (depicted in FIG. 8 of Kara as "US Post", "Federal Express", "DHL", "UPS", "Purolator", and "Emery") via each successively indicated "urgency".

Further, it is respectfully asserted that combining the Nicholls and/or Kara references with Barnett still does not disclose, anticipate, teach or suggest the above-recited limitations of Claim 1. Because, for the reasons described above, neither Nicholls nor Kara, whether considered alone or in combination, disclose, anticipate, teach or suggest the above-cited limitations of Claim 1, it is therefore respectfully submitted that combining Nicholls and/or Kara with a calendaring system such as Barnett does not disclose, anticipate, teach or suggest the limitations to "... generate a respective simultaneous cross-comparison display of respective shipping rates for each delivery service offered by each carrier of the plurality of carriers that would ship the respective parcel ..." as recited in Claim 1.

Therefore, it is respectfully submitted that the rejection failed to indicate, as required under MPEP §2143, how Nicholls, Kara and/or Barnett, even when combined, disclose, anticipate, teach or suggest the above-recited limitation of Claim 1 (or similar limitations recited by Claims 8 and 15).

Yet further, for reasons similar to those described above regarding the rejection of Claims 1, 8 and 15 with respect to Nicholls, Kara and/or Barnett, it is respectfully asserted that independent Claims 2-3, 9-10 and 16-17 of the present application recite limitations for which the rejection failed to indicate, as required under MPEP §2143, any disclosure, anticipation, teaching or suggesting by the cited references, even when combined. For example, Claim 2 recites (and Claims 9 and 16 similarly recite), among other things, limitations to:

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... generate a simultaneous online display comprising an identification of a plurality of delivery services for each carrier of the plurality of carriers that would support shipping of the particular respective parcel from the respective user-specific default shipping location. ...

For reasons similar to those previously given above with respect to Claims 1, 8 and 15, it is therefore respectfully submitted that the rejection failed to indicate, as required under MPEP §2143, how *Nicholls*, *Kara* and/or *Barnett*, even when combined, disclose, anticipate, teach or suggest the above-recited limitations of Claims 2, 9 and 16.

For reasons similar to those described above with respect to limitations of independent Claims 1, 8 and 15, and with respect to limitations of independent Claims 2, 9, and 16, it is respectfully asserted that the rejection failed to indicate, as required under MPEP §2143, how *Nicholls*, *Kara* and/or *Barnett*, even when combined, disclose, anticipate, teach or suggest the limitation recited in independent Claims 3, 10, and 17 for:

... generat[ing] a simultaneous online display identifying a plurality of delivery services for each respective carrier of the plurality of carriers that would support shipping of the particular parcel from the respective default shipping location.

It is therefore respectfully asserted that independent Claims 1-3, 8-10, and 15-17, and the claims dependent on them, are patentable over the cited references.

C. CONCLUSION

For the foregoing reasons, it is respectfully submitted that the invention disclosed and claimed in the present application is not fairly taught by any of the references of record, taken either alone or in combination, and that the application is in condition for allowance. Accordingly, reconsideration and allowance of the application is respectfully requested.

Respectfully submitted,

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